

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEFAN DOPKE
and BURKHARD MAASS

Appeal No. 98-2152
Application 08/638,429¹

ON BRIEF

Before COHEN, MEISTER, and ABRAMS, Administrative Patent Judges.

MEISTER, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed April 26, 1996. According to appellants, this application is a division of Application 08/536,999, filed September 29, 1995, now abandoned.

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Stefan Dopke and Burkhard Maass (the appellants) appeal from the final rejection of claims 5-11, 15 and 16.² Claims 12 and 13, the only other claims remaining in the application, have been indicated as being allowable subject to the requirement that they be rewritten to include all of the subject matter of the claims from which they depend.

The appellants' invention pertains to a sheet processing machine having a feeding table and a sheet-guiding assembly. The machine includes a "hold-downer" (a hold-down device) that is slidably disposed towards and away from the table and a spring having an adjustable spring force that bears against the hold-downer. Independent claim 5 is further illustrative of the appealed subject matter and a copy thereof may be found in the Appendix to the brief.

The reference relied on by the examiner is:

Bakke	1,068,406	Jul. 29, 1913
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² Claims 5 and 16 have been amended subsequent to final rejection by an amendment filed on June 7, 1997 (Paper No. 9). Although the advisory action mailed on August 6, 1997 (Paper No. 10) indicated that this amendment would be entered for purposes of appeal, we note that no clerical entry of this amendment has in fact been made.

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Claims 5-11, 15 and 16 stand rejected under 35 U.S.C.
§ 102(b) as being anticipated by Bakke. Pages 3 and 4 of the
answer state that:

Bakke discloses a sheet guiding device,
comprising:

[construction # 1: withdrawn by the Examiner]

[construction # 2]

-stationary hold-downer (31, 41, 40) disposed
above a feeding table 14 and being slidably disposed
towards and away from the feeding table (note slot
connection 42) for adjusting a spaced distance
there-between (page 2, line[s] 60-100, via screw
48);

-energy storer 38 having an adjustable spring
force (the spring force changes with changing spring
length) bearing against the sheet hold-downer; said
hold-downer slidably displaceble [sic] counter to
said spring force.

[construction # 3]

-stationary hold-downer (18, 32, 31, 41, 40)
disposed above a feeding table and being slidably
disposed towards and away from the feeding table
(both horizontal and vertical sliding movement);

-energy storer 28 having an adjustable spring
force (via adjusting nut 26).

We will not support the examiner's position. A prior art
reference anticipates the subject matter of a claim when that
reference discloses every feature of the claimed invention,

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either explicitly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and *Hazani v. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997).

With respect to construction #2, the examiner has identified the elements 31, 40 and 41 as corresponding to the claimed hold-downer. We must point out, however, that independent claim 5 expressly requires that the hold-downer be "disposed above the feeding table" and independent claim 16 specifies that the hold-downer have a hold-down member disposed "a spaced distance from the feeding table." Although the spring guide 40 and the adjusting plate 41 of Bakke satisfy these limitations, stop plate 31 does not. That is, Bakke expressly states that the stop plate 31 is biased toward the table in such a manner that the lower corners 39 thereof "rest on the feed table 14" (page 2, lines 23-50).

Moreover, we cannot agree with the examiner that the springs 35 (in conjunction with lugs 36 and 37) of Bakke can be fairly considered to provide "an adjustable spring force" (independent claim 5) or a "means for adjusting a spring

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force" (independent claim 16). Apparently, the examiner believes that Bakke can be considered to have an adjustable spring force and a means for adjusting a spring force because the stop plate 31 is biased toward the table by springs 35, and the force of the spring "changes with changing spring length." In Bakke, however, the springs 35 only bias the stop plate 31 toward the table a very short distance in order to accommodate any unevenness in the table top (see page 2, lines 14-50) and any change in the force of the spring would, at the most, be minuscule. Terms in a claim should be construed in a manner consistent with the specification and construed as those skilled in the art would construe them (***see In re Bond***, 910 F.2d 831, 833, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990), ***Specialty Composites v. Cabot Corp.***, 845 F.2d 981, 986, 6 USPQ2d 1601, 1604 (Fed. Cir. 1988) and ***In re Sneed***, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983)). Here, we can think of no circumstances under which the artisan, consistent with the appellants' specification, would construe the small movement of Bakke's springs to provide an adjustable spring force as set forth in independent claim 5, much less a means

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for adjusting a spring force as set forth in independent claim 16.

As to construction #3, the examiner has identified the elements 18, 32, 31, 40 and 41 of Bakke as corresponding to the claimed hold-downer. However, for the reasons stated above with respect to construction #2, the stop plate 31 cannot be considered to be disposed or spaced above the table as expressly required by independent claims 5 and 16. Moreover, even if the spring 28 and adjustable nut 26 of Bakke are broadly considered to provide an adjustable spring force (see independent claim 5) and a means for adjusting a spring force (see independent claim 16), this spring force does not bear "against" the supporting plate 32, the spring guide 40 and the adjusting plate 41. Since Bakke does not disclose every feature of the claimed invention, either explicitly or inherently, we will not sustain the rejection of claims 5-11, 15 and 16 under 35 U.S.C. § 102(b) as being anticipated by Bakke.

The decision of the examiner is reversed.

REVERSED

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	Irwin Charles Cohen)	
	Administrative Patent Judge)	
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	James M. Meister)	BOARD OF
PATENT)	
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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)	
	Neal A. Abrams)	
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